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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/024,923 02/17/98 KIKINIS

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CENTRAL COAST PATENT AGENCY
PO BOX 187
AROMAS CA 95004

EXAMINER

KWCH, J

ART UNIT

PAPER NUMBER

2663

DATE MAILED:

12/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

K

Office Action Summary

Application No.
09/024,923

Applicant(s)
KIKINIS

Examiner
Jasper Kwok

Group Art Unit
2663



☒ Responsive to communication(s) filed on Oct 6, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Feb 17, 1998 is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Oct 6, 2000 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on 10/16/00. These drawings are approved.
2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show a bridge for two connection-oriented networks as described in claim 17. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/036,358. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claims merely broaden the scope of the copending application's claims by not claiming some elements (i.e., a telephone apparatus). The application's claims are nearly identical in every other respect to the copending claims. Therefore, the application's claims are simply broader versions of the copending claims. It is the examiner's position that broadening the copending claims by not claiming some of claim elements (i.e., telephone apparatus) of the copending claims would have been obvious to one of the ordinary skill in the art in view of the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/041,370. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claims merely broaden the scope of the patented claims by not claiming some elements (i.e. a DNT call center, a CTI server, network router). The application's claims are nearly identical in every other respect to the copending application's claims. Therefore, the application's claims are simply broader versions of the

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copending claims. It is the examiner's position that broadening the copending claims by not claiming some of claim elements (i.e. a DNT call center, a CTI server, network router) of the copending claims would have been obvious to one of the ordinary skill in the art in view of the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-4, 7-10 and 13-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Williams et al.

Regarding claims 1 and 13, Williams et al. discloses bridge unit comprising: a trunk-line port for receiving and placing COST calls (i.e. 14, 15); a data network port for receiving and placing DNT calls; conversion circuitry (i.e. 15); control routines wherein a first call is dynamically converted and placed on the other network (i.e. col. 5, ll. 15-25).

Regarding claim 7, Williams et al. discloses a method for converting calls comprising: connecting a COST trunk line to a trunk-line port (i.e. 14, 15); connecting a data network line to a data network port (i.e. 15, 16); receiving a first call (i.e. fig. 1A); placing a second call (i.e. 1B); and dynamically convert data (i.e. col. 5, ll. 15-25).

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Regarding claims 2, 8 and 14-15, Williams et al. disclose the first network being a PSTN (i.e. 11-14) and the second the internet (i.e. 10).

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 3-4 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. in view of Ito et al.

Williams et al. does not specifically discloses retrieving IP address using a telephone number and accessing a look-up table to place a call. However, Ito et al. discloses address using a telephone number and accessing a look-up table to place a call (i.e. 4). It would have been obvious to an ordinary person skilled in the art at the time of the invention to include a converting table as taught by Ito et al. with the method and apparatus of Williams et al. in order to route calls from IP environment to PSTN and vis versa.

Claims 5-6 and 11-12 rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. in view of Iwami et al.

Williams et al. do not specifically disclose negotiating with the caller to ascertain the number using an interactive voice response unit (IVR). However, Iwami et al. teach the use of IVR (i.e. fig. 5) in a voice communication system to obtain the desired address or phone number (i.e. abstract). It would have been obvious to an ordinary person skilled in the art at the time of

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the invention to include an IVR to audibly receive the desired information as taught by Iwami et al. with the system and method of Williams et al. in order to provide customers with greater ease and friendlier atmosphere when placing a call.

10. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al.

Williams do not specifically disclose a bridge between two COST or DNT. However, Williams teaches that two different networks with two different protocols needs to be connected by a bridge as described above. Therefore it would have been obvious to modify by including converting protocols of two COST and two DNT with the bridge as discribed above in order to have the user to communicate through different systems.

Response to Arguments

11. Applicant's arguments filed 10/6/00 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. single unit, caller and the destination on separate networks) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Regarding claim 1, applicant asserts Williams does not perform the claimed invention in one unit, does not disclose port and circuitry for receiving and placing calls as claimed, and calls take place between different networks. Examiner disagrees. Williams does disclose the bridge to be one unit (i.e. 20). Williams does disclose port and circuitry which are shown by the connection of the lines to the box. Furthermore, circuitry are inherent in the system in order for it to use the algorithms to manipulate packets and signals. Finally, Williams does disclose the users on two different networks such as the one used by T1 and a different one used by T4.

Regarding claim 7, Examiner emphasizes that the claim do not have any limitation regarding two people engaged in a live conversation where one is on a PSTN and the other is on the Internet.

Regarding claim 13, it remains rejected because claim 1 remained rejected.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Goeddel et al. is cited to show a signal processing resource allocation for internet-based telephony.

b. Voit is cited to show an enhanced internet domain name server.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasper Kwoh whose telephone number is (703) 305-0101.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen, can be reached on (703) 308-5340.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

14. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

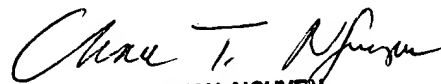
Or:

(703) 305-3988 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Jasper Kwoh


December 18, 2000


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